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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

MMB Docket No. **1576-0083**

Bosch Reference: **R70501**

Application of: **Brad M. Baber**

Serial No. **10/680,632**

Filed: **October 7, 2003**

Title: **Guide Assembly for a Hand-Held Power Tool**

Group Art Unit: **3725**

Examiner: **Bena B. Miller**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on
February 21, 2007
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February 21, 2007
Date of Signature

LETTER

Sir:

Please find for filing in connection with the above patent application the following documents.

1. Amended Appeal Brief (40 pages); and
2. One (1) return post card.

The $500.00 fee required under 37 C.F.R. §41.20 (b)(2) has previously been submitted. However, please charge any fee deficiency or credit any overpayment to Deposit Account No. 13-0014.

Respectfully submitted,

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February 21, 2007
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Serial No. **10/680,632** Examiner: **B. Miller**

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Paul J. Maginot
Name of person mailing Document or Fee

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Signature of person mailing Document or Fee

February 21, 2007
Date of Signature

AMENDED APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is an appeal to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the rejection of the claims 12-27

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of the above-identified patent application. These claims have been finally rejected in an Office Action dated July 3, 2006. The $500.00 fee required under 37 CFR § 1.17(c) was previously submitted. Also, please provide any extensions of time that may be necessary and charge any fees that may be due to Deposit Account No. 13-0014, but not to include any payment of issue fees.

(1) REAL PARTY IN INTEREST

Credo Technology Corporation of Broadview, Illinois is the assignee of this patent application, and the real party in interest.

(2) RELATED APPEALS AND INTERFERENCES

None.

(3) STATUS OF CLAIMS

Claims 1-11 are canceled.

Claims 12-27 are pending in the application.

Claims 12-27 are finally rejected.

Claims 12-27 are being appealed.

Claims 12-27 are shown in the Claim Appendix attached to this Appeal Brief.

(4) STATUS OF AMENDMENTS

Appellants have filed no amendments subsequent to the final rejection contained in the Office Action mailed July 3, 2006.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

Claim 12 is summarized as follows:

A first aspect of Appellant's invention relates to a guide assembly for a hand-held power tool. (See, e.g., Appellant's Figs. 1, 6, 11; and specification at page 13, line 28 through page 14, line 14.) The guide assembly includes a base 12 having a bottom surface 15 and defining an internally threaded opening 69 through which a bit of the hand-held power tool may be advanced, the base 12 further having a ledge 122 located within the internally threaded opening 69. (See, e.g., Appellant's specification at page 7, lines 11-13; page 13, second to last line through page 14, line 2; page 14, lines 8-9; and Figs. 1, 11.) The guide assembly further includes a guide 70 at least partially positioned within the internally threaded opening 69, the guide 70 having (i) a first portion 124 defining a first central passage 126 that is aligned with the internally threaded opening 69, and including a lower end portion extending vertically below the bottom surface 15 of the base 12, and (ii) a second portion 128 extending from an upper end portion of the first portion and positioned in contact with the ledge 122 of the base 12. (See, e.g., Appellant's specification at page 14, lines 1-10; and Figs. 1, 11.) Also, the guide assembly includes an externally threaded member 72 meshingly engaged with the internally threaded opening 69 of the base 12 and positioned in contact with the second portion 128 of the guide 70, the externally threaded member 72 defining a second central passage that is aligned with the internally threaded opening 69. (See, e.g., Appellant's specification at page 14, lines 11-13; and Figs. 1, 11.)

Claims Dependent on Claim 12 are summarized as follows:

The first portion 124 of the guide 70 includes a cylindrical structure 124 that defines the first central passage 126, and a lower end of portion of the cylindrical structure 124 extends vertically below the bottom surface 15 of the base 12. (See, e.g., Appellant's specification at page 14, lines 1-7; and Figs. 1 and 11.) The second portion 128 of the guide 70 includes an annular flange 128 extending from an upper end portion of the cylindrical structure 124, and the annular flange 128 is interposed between the externally threaded member 72 and the ledge 122 of the base 12. (See, e.g., Appellant's specification at page 14, lines 9-13; and Figs. 1, 11.) An upper surface of the annular flange 128 is positioned in contact with the externally threaded member 72, and a lower surface of the annular flange 128 is positioned in contact with the ledge 122. (See, e.g., Appellant's specification at page 14, lines 9-13; and Figs. 1, 11.) The externally threaded member 72 includes a pair of finger contact members 134 extending upwardly from a top surface thereof. (See, e.g., Appellant's specification at page 14, lines 13-14; and Figs. 1, 11.)

Claim 18 is summarized as follows:

A further aspect of the invention relates to a guide assembly for a hand-held power tool. (See, e.g., Appellant's Figs. 1, 6, 11; and specification at page

13, line 28 through page 14, line 14.) The guide assembly includes a base 12 having a substantially planar bottom surface 15 and defining an internally threaded opening 69 through which a bit of the hand-held power tool may be advanced, the base 12 further having a ledge 122 positioned at least partially around a periphery of the internally threaded opening 69. (See, e.g., Appellant's specification at page 7, lines 11-13; page 13, second to last line through page 14, line 2; page 14, lines 8-9; and Figs. 1, 11.) The guide assembly further includes a guide 70 at least partially positioned within the internally threaded opening 69, the guide 70 having (i) a cylindrical portion 124 defining a first central passage 126 that is aligned with the internally threaded opening 69, and including a lower end portion extending vertically below the bottom surface 15 of the base 12, and (ii) an annular flange 128 extending circumferentially from the cylindrical portion 124 and positioned in contact with the ledge 122 of the base 12. (See, e.g., Appellant's specification at page 14, lines 1-10; and Figs. 1, 11.) In addition, the guide assembly includes an externally threaded member 72 meshingly engaged with the internally threaded opening 69 of the base 12 and positioned in contact with the annular flange 128 of the guide 70, the externally threaded member 72 defining a second central passage that is aligned with the internally threaded opening 69. (See, e.g., Appellant's specification at page 14, lines 11-13; and Figs. 1, 11.)

Claims Dependent on Claim 18 are summarized as follows:

An upper surface of the annular flange 128 is positioned in contact with the externally threaded member 72, and a lower surface of the annular flange 128 is positioned in contact with the ledge 122. (See, e.g., Appellant's specification at page 14, lines 9-13; and Fig. 1.) The externally threaded member 72 includes a pair of finger contact members 134 extending upwardly from a top surface thereof. (See, e.g., Appellant's specification at page 14, lines 13-14; and Fig. 1.) The base 12 includes an internally threaded portion 120 that defines the internally threaded opening 69, and the ledge 122 is positioned vertically below the internally threaded portion 120. (See, e.g., Appellant's specification at page 13, second to last line through page 14, line 2; and Figs. 1, 11.)

Claim 22 is summarized as follows:

Yet another aspect of the present invention relates to an assembly. The assembly includes a base 12 having a bottom surface 15 and defining an internally threaded opening 69 and a ledge 122 located within the internally threaded opening 69. (See, e.g., Appellant's specification at page 7, lines 11-13; page 13, second to last line through page 14, line 2; page 14, lines 8-9; and Figs. 1, 11.) The assembly includes a guide 70 at least partially positioned within the internally threaded opening 69, the guide 70 having (i) a first portion 124 defining a central passage 126 and including a lower end portion extending vertically below the bottom surface 15 of the base 12, and (ii) a second portion 128 extending circumferentially from an upper end portion of the first portion 124 and positioned in contact with the ledge 122 of the base 12. (See, e.g., Appellant's specification at page 14, lines 1-10; and Figs. 1, 11.) Additionally, the assembly includes an externally threaded member 72 meshingly engaged with the internally threaded opening 69 of the base 12 and positioned in contact with the second portion 128 of the guide 70. (See, e.g., Appellant's specification at page 14, lines 11-13; and Figs. 1, 11.) The assembly also includes a hand-held power tool R at least a portion of which extends through the internally threaded opening 69 of the base 12 during operation of the hand-held power tool. (See, e.g., Appellant's specification at page 14, lines 8-9; page 4, lines 3-8; and Figs. 1, 6, 11.)

Claims Dependent on Claim 22 are summarized as follows:

The first portion 124 of the guide 70 includes a cylindrical structure 124 that defines the central passage 126, and a lower end of portion of the cylindrical structure 124 extends vertically below the bottom surface 15 of the base 12. (See, e.g., Appellant's specification at page 14, lines 1-7; and Figs. 1 and 11.) The second portion 128 of the guide 70 includes an annular flange 128 extending from an upper end portion of the cylindrical structure 124, and the annular flange 128 is interposed between the externally threaded member 72 and the ledge 122 of the base 12. (See, e.g., Appellant's specification at page 14, lines 9-13; and Fig. 1.) An upper surface of the annular flange 128 is positioned in contact with the externally threaded member 72, and a lower surface of the annular flange

128 is positioned in contact with the ledge 122. (See, e.g., Appellant's specification at page 14, lines 9-13; and Figs. 1, 11.) The externally threaded member 72 includes a pair of finger contact members 134 extending from a top surface thereof. (See, e.g., Appellant's specification at page 14, lines 13-14; and Figs. 1, 11.) The base 12 includes an internally threaded portion 120 that defines the internally threaded opening 69, and the ledge 122 is positioned vertically below the internally threaded portion 120. (See, e.g., Appellant's specification at page 13, second to last line through page 14, line 2; and Figs. 1, 11.)

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 12-27 stand rejected under 35 U.S.C. § 102 as being anticipated by Bethke (U.S. Patent No. 3,768,918).

Claims 12-27 stand rejected under 35 U.S.C. § 102 as being anticipated by Tsui et al. (U.S. Patent No. 4,770,570).

(7) ARGUMENT

I. First Rejection under 35 U.S.C. § 102 by Bethke (U.S. Patent No. 3,768,918)

Claims 12-27 are not anticipated under 35 U.S.C. § 102 by Bethke (U.S. Patent No. 3,768,918)

Discussion Regarding Patentability of Claim 12

In an attempt to identify where Bethke discloses the limitations of claim 12, the following was stated in the July 3, 2006 Office Action at page 2, last seven lines:

> The device of Bethke or Tsui ('570) reads on the structural limitations of the claims including a base (12 or 67, respectively) having a bottom surface (fig. 1 or fig. 7), an internally threaded [opening] (19 or fig. 7) and a ledge (17 or the upper circular portion of 67 as shown in fig. 7), a guide (11 or fig. 7, respectively) having a first portion (fig. 4 or 58) and a lower end portion (fig. 4 or the bottom portion of 70) and a second end portion (14), an externally threaded member (15 or fig. 3 or fig. 7, respectively), an annular flange (fig. 1 or 68, respectively) and pair of finger contact members (43 and 44 of Tsui et al '570).

Thus, it appears that the Examiner is equating the following claim elements of claim 12 with the following components of Bethke:

Claim Elements of Claim 12	**Bethke Teachings**
a *base* having a bottom surface	Lock ring 12
and defining an *internally threaded opening* through which a bit of the hand-held power tool may be advanced,	Internally threaded opening defined by threads 19 of lock ring 12
said base further having a *ledge* located within said internally threaded opening	Structure of lock ring 12 defined by the lower part of notch 17
a *guide* at least partially positioned within said internally threaded opening, said guide having	Bushing 11
(i) a *first portion* defining a first central passage that is aligned with said internally threaded opening, and including a lower end portion extending vertically below said bottom surface of said base, and	Unidentified component shown in Fig. 4 - (presumably exteriorly knurled portion 16 of bushing 11 located above the chamfered portion 14 and below exteriorly threaded portion 15)
(ii) a *second portion* extending from an upper end portion of said first portion and positioned in contact with said ledge of said base	Chamfered portion 14 of bushing 11
an *externally threaded member* meshingly engaged with said internally threaded opening of said base and positioned in contact with said second portion of said guide, said externally threaded member defining a second central passage that is aligned with said internally threaded opening	Exteriorly threaded portion 15 of bushing 11

Numerous distinctions exist between the Bethke device and the guide assembly defined by Appellant's claim 12.

For instance, the Examiner appears to have equated Bethke's (i) chamfered portion 14 of bushing 11 with the claimed second portion of the guide, and (ii) the lower part of the notch 17 structure with the claimed ledge. However, the chamfered portion 14 is not positioned in contact with lower part of the notch 17 structure as required by claim 12. Rather, as shown in Bethke's Fig. 5, the lower part of the notch 17 structure is clearly spaced apart from the chamfered portion 14 of bushing 11.

As another example, the Examiner appears to have equated Bethke's (i) exteriorly threaded portion 15 of bushing 11 with the claimed externally threaded member, and (ii) as stated above, the chamfered portion 14 of bushing 11 with the claimed second portion of the guide. However, the exteriorly threaded portion 15 of bushing 11 is not positioned in contact with the chamfered portion 14 of bushing 11 as required by claim 12. In contrast, as can be seen in any of Bethke's Figs. 1, 3, 4, and 5, the exteriorly threaded portion 15 of bushing 11 is clearly spaced apart from the chamfered portion 14 of bushing 11. Indeed, the entire knurled portion of the bushing 11 (presumably equated with the claimed first portion of the guide) is interposed therebetween.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Bethke does not disclose each and every element of Appellant's claim 12, Bethke does not anticipate Appellant's claim 12.

Discussion Re: Patentability of Claims 13-17

Each of claims 13-17 depends directly or indirectly from claim 12. As a result, each of claims 13-17 is allowable over Bethke for, at least, the reasons hereinbefore discussed with regard to claim 12. Moreover, each of claims 13-17 recites additional novel and non-obvious limitations.

For example, claim 14 recites:

> said annular flange is interposed between said externally threaded member and said ledge of said base.

The Examiner appears to have equated Bethke's (i) chamfered portion 14 of bushing 11 with the claimed annular flange of the second portion of the guide (see, e.g., July 3, 2006 Office Action at page 2, last two lines), (ii) exteriorly threaded portion 15 of bushing 11 with the claimed externally threaded member, and (iii) the lower part of the notch 17 structure with the claimed ledge. However, the chamfered portion 14 of the bushing 11 is not interposed between the exteriorly threaded portion 15 of bushing 11 and the lower part of the notch 17 structure as required by claim 14. This can be clearly seen in Bethke's Fig. 5 where the chamfered portion 14 of bushing 11 is positioned below both the exteriorly threaded portion 15 of bushing 11 and the lower part of the notch 17 structure.

Moreover, for example, claim 15 recites:

> an upper surface of said annular flange is positioned in contact with said externally threaded member, and
>
> a lower surface of said annular flange is positioned in contact with said ledge.

However, the upper surface of Bethke's chamfered portion 14 of bushing 11 is not positioned in contact with Bethke's exteriorly threaded portion 15 of bushing 11 as required by claim 15. In addition, the lower surface of Bethke's chamfered portion 14 of bushing 11 is not positioned in contact with the lower part of the notch 17 structure of Bethke's lock ring 12. This can be clearly seen in Bethke's Fig. 5.

Additionally, for example, claim 16 recites:

> said externally threaded member includes a pair of finger contact members extending upwardly from a top surface thereof.

Bethke's exteriorly threaded portion 15 of bushing 11 does not include a pair of finger contact members extending upwardly from a top surface thereof as required by claim 16. Nor has the Examiner identified any structure in Bethke which does meet this limitation.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Bethke does not disclose each and every element of Appellant's claims 13-17, Bethke does not anticipate Appellant's claims 13-17.

Discussion Re: Patentability of Claim 18

Claim 18 recites the following:

> a guide ..., said guide having ... an annular flange ... positioned in contact with said ledge of said base; and
>
> an externally threaded member ... positioned in contact with said annular flange of said guide, ...

The Examiner appears to have equated Bethke's (i) chamfered portion 14 of bushing 11 with the claimed annular flange (see, e.g., July 3, 2006 Office Action at page 2, last two lines), (ii) exteriorly threaded portion 15 of bushing 11 with the claimed externally threaded member, and (iii) the lower part of the notch 17 structure with the claimed ledge. However, the chamfered portion 14 of the bushing 11 is not positioned in contact with the lower part of the notch 17 structure as required by claim 18. Likewise, the chamfered portion 14 of the bushing 11 is not positioned in contact with the exteriorly threaded portion 15 of bushing 11 as further required by claim 18. Fig. 5 of Bethke exposes these flaws of the Examiner's rejection.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Bethke does not disclose each and every element of Appellant's claim 18, Bethke does not anticipate Appellant's claim 18.

Discussion Re: Patentability of Claims 19-21

Each of claims 19-21 depends directly from claim 18. As a result, each of claims 19-21 is allowable over Bethke for, at least, the reasons hereinbefore discussed with regard to claim 18. Moreover, each of claims 19-21 recites additional novel and non-obvious limitations.

For example, claim 19 recites:

> an upper surface of said annular flange is positioned in contact with said externally threaded member, and
>
> a lower surface of said annular flange is positioned in contact with said ledge.

However, the upper surface of Bethke's chamfered portion 14 of bushing 11 is not positioned in contact with Bethke's exteriorly threaded portion 15 of bushing 11 as required by claim 19. In addition, the lower surface of Bethke's chamfered portion 14 of bushing 11 is not positioned in contact with the lower part of the notch 17 structure of Bethke's lock ring 12. These deficiencies can be clearly seen in Bethke's Fig. 5.

Additionally, for example, claim 20 recites:

> said externally threaded member includes a pair of finger contact members extending upwardly from a top surface thereof.

Bethke's exteriorly threaded portion 15 of bushing 11 does not include a pair of finger contact members extending upwardly from a top surface thereof as required by claim 20. Nor has the Examiner identified any structure in Bethke which does meet this limitation.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Bethke does not disclose each and every element of Appellant's claims 19-21, Bethke does not anticipate Appellant's claims 19-21.

Discussion Re: Patentability of Claim 22

Claim 22 recites the following:

> a guide ..., said guide having ... a second portion extending circumferentially from an upper end portion of said first portion and positioned in contact with said ledge of said base;
>
> an externally threaded member meshingly engaged with said internally threaded opening of said base and positioned in contact with said second portion of said guide ... .

The Examiner appears to have equated Bethke's (i) chamfered portion 14 of bushing 11 with the claimed second portion extending circumferentially from an upper end of said first portion, (ii) exteriorly threaded portion 15 of bushing 11 with the claimed externally threaded member meshingly engaged with said internally threaded opening, and (iii) the lower part of the notch 17 structure with the claimed ledge of said base. (See, e.g., July 3, 2006 Office Action at page 2.)

However, the chamfered portion 14 of the bushing 11 is not positioned in contact with the lower part of the notch 17 structure as required by claim 22. Likewise, the chamfered portion 14 of the bushing 11 is not positioned in contact with the exteriorly threaded portion 15 of bushing 11 as further required by claim 22. Fig. 5 of Bethke shows these deficiencies.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Bethke does not disclose each and every element of Appellant's claim 22, Bethke does not anticipate Appellant's claim 22.

Discussion Re: Patentability of Claims 23-27

Each of claims 23-27 depends directly or indirectly from claim 22. As a result, each of claims 23-27 is allowable over Bethke for, at least, the reasons hereinbefore discussed with regard to claim 22. Moreover, each of claims 23-27 recites additional novel and non-obvious limitations.

For example, claim 24 recites:

> said annular flange is interposed between said externally threaded member and said ledge of said base.

The Examiner appears to have equated Bethke's (i) chamfered portion 14 of bushing 11 with the claimed annular flange of the second portion of the guide (see, e.g., July 3, 2006 Office Action at page 2, last two lines), (ii) exteriorly threaded portion 15 of bushing 11 with the claimed externally threaded member, and (iii) the lower part of the notch 17 structure with the claimed ledge. However, the chamfered portion 14 of the bushing 11 is not interposed between the exteriorly threaded portion 15 of bushing 11 and the lower part of the notch 17 structure as required by claim 24. This can be clearly seen in Bethke's Fig. 5 where the chamfered portion 14 of bushing 11 is positioned below both the exteriorly threaded portion 15 of bushing 11 and the lower part of the notch 17 structure.

Moreover, for example, claim 25 recites:

> an upper surface of said annular flange is positioned in contact with said externally threaded member, and
>
> a lower surface of said annular flange is positioned in contact with said ledge.

However, the upper surface of Bethke's chamfered portion 14 of bushing 11 is not positioned in contact with Bethke's exteriorly threaded portion 15 of bushing 11 as required by claim 25. In addition, the lower surface of Bethke's chamfered portion 14 of bushing 11 is not positioned in contact with the lower part of the notch 17 structure of Bethke's lock ring 12. This can be clearly seen in Bethke's Fig. 5.

Additionally, for example, claim 26 recites:

> said externally threaded member includes a pair of finger contact members extending upwardly from a top surface thereof.

Bethke's exteriorly threaded portion 15 of bushing 11 does not include a pair of finger contact members extending upwardly from a top surface thereof as required by claim 26. Nor has the Examiner identified any structure in Bethke which does meet this limitation.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim.

Since Bethke does not disclose each and every element of Appellant's claims 13-17, Bethke does not anticipate Appellant's claims 23-27.

II. Second Rejection under 35 U.S.C. § 102 by Tsui et al. (U.S. Patent No. 4,770,570)

Claims 12-27 are not anticipated under 35 U.S.C. § 102 by Tsui et al. (U.S. Patent No. 4,770,570)

Claims 12-27 were rejected under 35 U.S.C. § 102 as being anticipated by Tsui (U.S. Patent No. 4,770,570). Reconsideration of claims 12-27 is respectfully requested.

Discussion Regarding Patentability of Claim 12

In an attempt to identify where Tsui '570 discloses the limitations of claim 12, the following was stated in the July 3, 2006 Office Action as page 2, last seven lines:

> The device of Bethke or Tsui ('570) reads on the structural limitations of the claims including a base (12 or 67, respectively) having a bottom surface (fig. 1 or fig. 7), an internally threaded [opening] (19 or fig. 7) and a ledge (17 or the upper circular portion of 67 as shown in fig. 7), a guide (11 or fig. 7, respectively) having a first portion (fig. 4 or 58) and a lower end portion (fig. 4 or the bottom portion of 70) and a second end portion (14), an externally threaded member (15 or fig. 3 or fig. 7, respectively), an annular flange (fig. 1 or 68, respectively) and pair of finger contact members (43 and 44 of Tsui et al '570).

Thus, it appears that the Examiner is equating the following claim elements of claim 12 with the following components of Tsui '570:

Claim Elements of Claim 12	**Tsui '570 Teachings**
a *base* having a bottom surface	Flat nut 67 (See fig. 7 of Tsui '570)
and defining an *internally threaded opening* through which a bit of the hand-held power tool may be advanced,	Internally threaded opening defined by internal threads of flat nut 67 (See fig. 7 of Tsui '570)
said base further having a *ledge* located within said internally threaded opening	Upper circular portion of flat nut 67 as shown in Fig. 7 of Tsui '570
a *guide* at least partially positioned within said internally threaded opening, said guide having	Upper part of subassembly component shown in Fig. 7 having flange 68 and serrated section 70 (see page 3 of Office Action)
(i) a *first portion* defining a first central passage that is aligned with said internally threaded opening, and including a lower end portion extending vertically below said bottom surface of said base, and	*First portion* identified as guide bore 58 in Office Action at page 3 *Lower end portion* identified as bottom of exteriorly threaded section 7058 in Office Action at page 3
(ii) a *second portion* extending from an upper end portion of said first portion and positioned in contact with said ledge of said base	Flange 68 of subassembly component shown in Fig. 7
an *externally threaded member* meshingly engaged with said internally threaded opening of said base and positioned in contact with said second portion of said guide, said externally threaded member defining a second central passage that is aligned with said internally threaded opening	Lower part of subassembly component shown in Fig. 7 having exteriorly threaded portion 64 that is located below annular serrated section 70

Much distinction exists between the Tsui '570 device and the guide assembly defined by Appellant's claim 12.

For instance, the Examiner appears to have equated (i) the exteriorly threaded section 64 of Tsui's subassembly component shown in Fig. 7 with the claimed externally threaded member, and (ii) the flange 68 of Tsui's subassembly component shown in Fig. 7 with the claimed second portion of the guide.

However, the exteriorly threaded section 64 is not positioned in contact with the flange 68 as required by claim 12. Rather, as shown in Tsui's Fig. 7, the exteriorly threaded section 64 is clearly spaced apart from the flange 68. Indeed, the serrated section 70 and the non-threaded section juxtaposed below it are interposed between the exteriorly threaded section 64 and the flange 68.

As a further example, the Examiner appears to have equated (i) the upper part of the subassembly component shown in Fig. 7 having flange 68 and serrated section 70 with the claimed guide, and (ii) the internally threaded opening defined by the internal threads of flat nut 67 with the claimed internally threaded opening of said base. However, the upper part of the subassembly component shown in Fig. 7 having flange 68 and serrated section 70 is not at least partially positioned within the internally threaded opening defined by the internal threads of flat nut 67 as called for in claim 12. Significantly, Fig. 8 of Tsui '570 shows that the only structure located within the internally threaded opening defined by the internal threads of flat nut 67 is the exteriorly threaded section 64 of Tsui's subassembly component shown in Fig. 7 (which is already equated with the claimed externally threaded member).

As another example, the Examiner appears to have equated the exteriorly threaded section 64 of Tsui's subassembly component shown in Fig. 7 with the claimed externally threaded member. However, the Examiner further attempts to equate the lower end portion of the first portion of the guide with the same structure of Tsui. (See, e.g., the lead line of the "lower end portion" on page 3 of the Office Action dated July 3, 2006.) Tsui '570 does not include structure that meets both of these limitations of claim 12.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Tsui '570 does not disclose each and every element of Appellant's claim 12, Tsui '570 does not anticipate Appellant's claim 12.

Discussion Re: Patentability of Claims 13-17

Each of claims 13-17 depends directly or indirectly from claim 12. As a result, each of claims 13-17 is allowable over Tsui '570 for, at least, the reasons hereinbefore discussed with regard to claim 12. Moreover, each of claims 13-17 recites additional novel and non-obvious limitations.

For example, claim 15 recites:

> an upper surface of said annular flange is positioned in contact with said externally threaded member, and
>
> a lower surface of said annular flange is positioned in contact with said ledge.

The Examiner appears to have equated Tsui '570's (i) flange 68 of subassembly component shown in Fig. 7 with the claimed annular flange of the second portion of the guide(see, e.g., July 3, 2006 Office Action at page 2, last two lines), (ii) exteriorly threaded section 64 of Tsui's subassembly component shown in Fig. 7 with the claimed externally threaded member, and (iii) the upper circular portion of flat nut 67 with the claimed ledge. However, the upper surface of the flange 68 is not positioned in contact with exteriorly threaded section 64 of Tsui's subassembly component shown in Fig. 7 as required by claim 15.

Furthermore, the lower surface of the flange 68 is not positioned in contact with the upper circular portion of flat nut 67. This can be clearly seen in Tsui's Fig. 8 where all surfaces of the flange 68 are spaced apart from both the exteriorly threaded section 64 and the upper circular portion of flat nut 67.

Additionally, for example, claim 16 recites:

> said externally threaded member includes a pair of finger contact members extending upwardly from a top surface thereof.

Tsui '570's exteriorly threaded section 64 does not include a pair of finger contact members extending upwardly from a top surface thereof as required by claim 16. As shown in Fig. 7 of Tsui '570, projections 43 and 44 are spaced apart from the exteriorly threaded section 64.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Tsui '570 does not disclose each and every element of Appellant's claims 13-17, Tsui '570 does not anticipate Appellant's claims 13-17.

Discussion Re: Patentability of Claim 18

Claim 18 recites the following:

> a guide at least partially positioned within said internally threaded opening ... ; and
>
> an externally threaded member ... positioned in contact with said annular flange of said guide, ...

The Examiner appears to have equated (i) the exteriorly threaded section 64 of Tsui's subassembly component shown in Fig. 7 with the claimed externally threaded member, and (ii) the flange 68 of Tsui's subassembly component shown in Fig. 7 with the claimed annular flange. However, the exteriorly threaded section 64 is not positioned in contact with the flange 68 as required by claim 18. (See, e.g., Fig. 7 of Tsui '570.)

Moreover, the Examiner appears to have equated (i) the upper part of the subassembly component shown in Fig. 7 having flange 68 and serrated section 70 with the claimed guide, and (ii) the internally threaded opening defined by the internal threads of flat nut 67 with the claimed internally threaded opening of said base. However, the upper part of the subassembly component shown in Fig. 7 having flange 68 and serrated section 70 is not at least partially positioned within the internally threaded opening defined by the internal threads of flat nut 67. Fig. 8 of Tsui '570 clearly shows that the only structure positioned within the internally threaded opening defined by the internal threads of flat nut 67 is the exteriorly threaded section 64 of Tsui's subassembly component.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Tsui '570 does not disclose each and every element of Appellant's claim 18, Tsui '570 does not anticipate Appellant's claim 18.

Discussion Re: Patentability of Claims 19-21

Each of claims 19-21 depends directly from claim 18. As a result, each of claims 19-21 is allowable over Tsui '570 for, at least, the reasons hereinbefore discussed with regard to claim 18. Moreover, each of claims 19-21 recites additional novel and non-obvious limitations.

For example, claim 19 recites:

> an upper surface of said annular flange is positioned in contact with said externally threaded member, and
> a lower surface of said annular flange is positioned in contact with said ledge.

However, the upper surface of the flange 68 is not positioned in contact with exteriorly threaded section 64 of Tsui's subassembly component shown in Fig. 7 as required by claim 19. Furthermore, the lower surface of the flange 68 is not positioned in contact with the upper circular portion of flat nut 67. This can be clearly seen in Tsui's Fig. 8 where all surfaces of the flange 68 are spaced apart from both the exteriorly threaded section 64 and the upper circular portion of flat nut 67.

Additionally, for example, claim 20 recites:

> said externally threaded member includes a pair of finger contact members extending upwardly from a top surface thereof.

Tsui '570's exteriorly threaded section 64 does not include a pair of finger contact members extending upwardly from a top surface thereof as required by claim 20. As shown in Fig. 7 of Tsui '570, projections 43 and 44 are spaced apart from the exteriorly threaded section 64.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Tsui '570 does not disclose each and every element of Appellant's claims 19-21, Tsui '570 does not anticipate Appellant's claims 19-21.

Discussion Re: Patentability of Claim 22

Claim 22 recites the following:

> a guide at least partially positioned within said internally threaded opening ... ;
>
> an externally threaded member meshingly engaged with said internally threaded opening of said base and positioned in contact with said second portion of said guide .... .

The Examiner appears to have equated (i) the exteriorly threaded section 64 of Tsui's subassembly component shown in Fig. 7 with the claimed externally threaded member, and (ii) the flange 68 of Tsui's subassembly component shown in Fig. 7 with the claimed second portion of said guide. However, the exteriorly threaded section 64 is not positioned in contact with the flange 68 as required by claim 22.

Moreover, the Examiner appears to have equated (i) the upper part of the subassembly component shown in Fig. 7 having flange 68 and serrated section 70 with the claimed guide, and (ii) the internally threaded opening defined by the internal threads of flat nut 67 with the claimed internally threaded opening of said base. However, the upper part of the subassembly component shown in Fig. 7 having flange 68 and serrated section 70 is not at least partially positioned within the internally threaded opening defined by the internal threads of flat nut 67. Fig. 8 of Tsui '570 clearly shows that the only component positioned with in the internally threaded opening of the flat nut 67 is the exteriorly threaded section 64.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim.

Since Tsui '570 does not disclose each and every element of Appellant's claim 22, Tsui '570 does not anticipate Appellant's claim 22.

Discussion Re: Patentability of Claims 23-27

Each of claims 23-27 depends directly or indirectly from claim 22. As a result, each of claims 23-27 is allowable over Tsui '570 for, at least, the reasons hereinbefore discussed with regard to claim 22. Moreover, each of claims 23-27 recites additional novel and non-obvious limitations.

For example, claim 25 recites:

> an upper surface of said annular flange is positioned in contact with said externally threaded member, and
>
> a lower surface of said annular flange is positioned in contact with said ledge.

The Examiner appears to have equated Tsui '570's (i) flange 68 of subassembly component shown in Fig. 7 with the claimed annular flange of the second portion of the guide (see, e.g., July 3, 2006 Office Action at page 2, last two lines), (ii) exteriorly threaded section 64 of Tsui's subassembly component shown in Fig. 7 with the claimed externally threaded member, and (iii) the upper circular portion of flat nut 67 with the claimed ledge. However, the upper surface of the flange 68 is not positioned in contact with exteriorly threaded section 64 of Tsui's subassembly component shown in Fig. 7 as required by claim 25. Furthermore, the lower surface of the flange 68 is not positioned in contact with the upper circular portion of flat nut 67. This can be clearly seen in Tsui's Fig. 8 where all surfaces of the flange 68 are spaced apart from both the exteriorly threaded section 64 and the upper circular portion of flat nut 67.

Additionally, for example, claim 26 recites:

> said externally threaded member includes a pair of finger contact members extending upwardly from a top surface thereof.

Tsui '570's exteriorly threaded section 64 does not include a pair of finger contact members extending upwardly from a top surface thereof as required by claim 26. As shown in Fig. 7 of Tsui '570, projections 43 and 44 are spaced apart from the exteriorly threaded section 64.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Tsui '570 does not disclose each and every element of Appellant's claims 13-17, Tsui '570 does not anticipate Appellant's claims 23-27.

III. Conclusion

Claims 12-27 are not anticipated under 35 U.S.C. § 102 by Bethke (U.S. Patent No. 3,768,918), and the Board of Appeals is respectfully requested to reverse this rejection of these claims.

Claims 12-27 are not anticipated under 35 U.S.C. § 102 by Tsui et al. (U.S. Patent No. 4,770,570), and the Board of Appeals is respectfully requested to reverse this rejection of these claims.

Respectfully submitted,

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(8) CLAIM APPENDIX

12. A guide assembly for a hand-held power tool, comprising:

a base having a bottom surface and defining an internally threaded opening through which a bit of the hand-held power tool may be advanced, said base further having a ledge located within said internally threaded opening;

a guide at least partially positioned within said internally threaded opening, said guide having (i) a first portion defining a first central passage that is aligned with said internally threaded opening, and including a lower end portion extending vertically below said bottom surface of said base, and (ii) a second portion extending from an upper end portion of said first portion and positioned in contact with said ledge of said base; and

an externally threaded member meshingly engaged with said internally threaded opening of said base and positioned in contact with said second portion of said guide, said externally threaded member defining a second central passage that is aligned with said internally threaded opening.

13. The guide assembly of claim 12, wherein:

said first portion of said guide includes a cylindrical structure that defines said first central passage, and

a lower end of portion of said cylindrical structure extends vertically below said bottom surface of said base.

14. The guide assembly of claim 13, wherein:

said second portion of said guide includes an annular flange extending from an upper end portion of said cylindrical structure, and

said annular flange is interposed between said externally threaded member and said ledge of said base.

15. The guide assembly of claim 14, wherein:

an upper surface of said annular flange is positioned in contact with said externally threaded member, and

a lower surface of said annular flange is positioned in contact with said ledge.

16. The guide assembly of claim 12, wherein said externally threaded member includes a pair of finger contact members extending upwardly from a top surface thereof.

17. The guide of assembly of claim 12, wherein:

said base includes an internally threaded portion that defines said internally threaded opening, and

said ledge is positioned vertically below said internally threaded portion.

18. A guide assembly for a hand-held power tool, comprising:

a base having a substantially planar bottom surface and defining an internally threaded opening through which a bit of the hand-held power tool may be advanced, said base further having a ledge positioned at least partially around a periphery of said internally threaded opening;

a guide at least partially positioned within said internally threaded opening, said guide having (i) a cylindrical portion defining a first central passage that is aligned with said internally threaded opening, and including a lower end portion extending vertically below said bottom surface of said base, and (ii) an annular flange extending circumferentially from said cylindrical portion and positioned in contact with said ledge of said base; and

an externally threaded member meshingly engaged with said internally threaded opening of said base and positioned in contact with said annular flange of said guide, said externally threaded member defining a second central passage that is aligned with said internally threaded opening.

19. The guide assembly of claim 18, wherein:

an upper surface of said annular flange is positioned in contact with said externally threaded member, and

a lower surface of said annular flange is positioned in contact with said ledge.

20. The guide assembly of claim 18, wherein said externally threaded member includes a pair of finger contact members extending upwardly from a top surface thereof.

21. The guide assembly of claim 18, wherein:

said base includes an internally threaded portion that defines said internally threaded opening, and

said ledge is positioned vertically below said internally threaded portion.

22. An assembly, comprising:

a base having a bottom surface and defining an internally threaded opening and a ledge located within said internally threaded opening;

a guide at least partially positioned within said internally threaded opening, said guide having (i) a first portion defining a central passage and including a lower end portion extending vertically below said bottom surface of said base, and (ii) a second portion extending circumferentially from an upper end portion of said first portion and positioned in contact with said ledge of said base;

an externally threaded member meshingly engaged with said internally threaded opening of said base and positioned in contact with said second portion of said guide; and

a hand-held power tool at least a portion of which extends through said internally threaded opening of said base during operation of said hand-held power tool.

23. The guide assembly of claim 22, wherein:

said first portion of said guide includes a cylindrical structure that defines said central passage, and

a lower end of portion of said cylindrical structure extends vertically below said bottom surface of said base.

24. The guide assembly of claim 23, wherein:

said second portion of said guide includes an annular flange extending from an upper end portion of said cylindrical structure, and

said annular flange is interposed between said externally threaded member and said ledge of said base.

25. The guide assembly of claim 24, wherein:

an upper surface of said annular flange is positioned in contact with said externally threaded member, and

a lower surface of said annular flange is positioned in contact with said ledge.

26. The guide assembly of claim 22, wherein said externally threaded member includes a pair of finger contact members extending from a top surface thereof.

27. The guide of assembly of claim 22, wherein:

said base includes an internally threaded portion that defines said internally threaded opening, and

said ledge is positioned vertically below said internally threaded portion.

(9) EVIDENCE APPENDIX

None.

(10) RELATED PROCEEDINGS APPENDIX

None.